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Jay Donahue

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07/07/2004

Banner & Witcoff LTD  
1001 G Street NW  
Washington, DC 20001-4597

EXAMINER

GREENE, DANIEL L

ART UNIT

PAPER NUMBER

3621

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/610,005  
Filing Date: July 05, 2000  
Appellant(s): DONAHUE, JAY

**MAILED**

JUL 07 2004

**GROUP 3600**

Ross A. Dannenberg  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/21/04

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

There are no related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-57 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

6,502,113	CRAWFORD et al.	12-2002
6,067,531	HOYT et al.	5-2000
6,112,189	RICKARD et al.	8-2000
5,897,621	BOESCH et al.	4-1999

6,321,202	RAVEIS, Jr.	11-2001
6,131,087	LUKE et al.	10-2000

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 1, 3, 11-15, 21-22, 30-42, 44, 46, 49, 50, and 52-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford et al. (U.S. Pat. No. 6,502,113 B1, hereinafter Crawford).
- Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Hoyt et al. (U.S. Pat. No. 6,067,531, hereinafter Hoyt).
- Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Rickard et al. (U.S. Pat. No. 6,112,189, hereinafter Rickard).

Claims 5, 6, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Boesch et al. (U.S. Pat. No. 5,897,621, hereinafter Boesch). • Claims 7-10, 18-20 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Raveis, Jr. (U.S. Pat. No. 6,321,202, hereinafter Raveis).

- Claims 23, 27 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke et al. (U.S. Pat. No. 6,131,087, hereinafter Luke).
- Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke and Raveis.

Art Unit: 3621

- Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke, Raveis, and Boesch.
- Claims 26 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke and Rickard.
- Claims 51 and 56-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Hoyt.

This rejection is set forth in a prior Office Action, mailed on 10/31/03.

**(11) *Response to Argument***

Appellant's arguments filed 4/21/04 have been fully considered but they are not persuasive.

The Appellant has presented 10 issues.

***Issue 1***

Claims 1, 3, 11-15, 21-22, 30-42, 44, 46, 49, 50, and 52-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford et al. (U.S. Pat. No. 6,502,113 BI, hereinafter Crawford).

**Claims 1, 3, and 13-15**

The Appellant argues that, "Crawford does not teach, suggest, or support the notion of a transaction having multiple, distinct phases, nor the concise negotiation of transaction milestones, as is recited in claims 1, 3 and 13-15. Nor does Crawford generate documents based upon decisions reached by the negotiating parties through a

structured transaction engine, as does the present invention (see p. 6, 11. 13-15 of original application). Pg. 8.

The Examiner disagrees in that Crawford describes an online system whereby two parties collaborate to edit a specific document having a plurality of negotiable clauses[ *multiple, distinct* phases](Crawford abstract),. The Crawford system uses an external base document, [ *generates documents* ] which must be imported, as a default position from which to begin online collaboration between the parties (Crawford, col. 8, lines 6163). Further, Crawford teaches, that the parties each review the document online and suggest changes and amendments to the actual text of the document (Crawford, col. 12, line 19 - col. 13, lines 5). Crawford allows for detailed editing of intricate contract language without incurring delays normally associated with substantial revisions (col. 12, lines 40-42).[ *concise negotiation of transaction milestones*]

The Appellant further argues , Crawford does not teach or suggest a plurality of lease provisions and a plurality of predefined actions associated with each lease provision, nor determining whether two parties have selected the same predefined action, as is required by claim 1. The Examiner disagrees in that Crawford actually states that what is taught therein is a universal document management system which allows two parties to divide a proposed contract or draft letter of agreement into issues [ *plurality of lease provisions and a plurality of predefined actions* ] which can be edited, thereby creating intermediate draft versions of the same document. Col. 2, lines 31-57.

In reference to “determining whether two parties have selected the same predefined action” , Crawford utilizes a color-coded system to show clauses that have yet to be negotiated, and clauses that have been agreed to. Col. 10, lines 40-55.

The Appellant further argues, Crawford does not teach or suggest a plurality of lease provisions and a plurality of predefined actions associated with each lease provision, nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase, as is required by claim 1. The Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. [*nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase*]

The Appellant further argues that, in Crawford, there are no predefined actions associated with each lease provision for a negotiator to select. Crawford can thus make no determination whether each of a plurality of negotiators has selected the same associated predefined action. PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention “ as a whole” would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., “lease provision”. Crawford teaches about negotiating a document. The limitations/steps required for negotiating a document, or a lease provision, or a purchase contract, as described by

Crawford, teaches to the limitations presented by the Appellant. The type of document being negotiated does not render an application allowable because these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The negotiating procedure taught would be performed the same regardless of the type of contract being negotiated.. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The Appellant further argues that, Crawford also does not teach or suggest "storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non agreed lease provisions to a later phase of the lease negotiation" as recited in claim 1. Because Crawford does not manage a transaction with phases, Crawford cannot affirmatively defer non-agreed lease provisions to a later phase, as does the present invention.

Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. [ *nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase*]

Claim 1 is thus rejected over Crawford because Crawford, does teach or suggest every limitation of claim 1.



In reference to the independent claim 14, The recitation , a computer system programmed” has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

Similar to claim 1, Crawford at least does teach or suggest the italicized portions of claim 14. Dependent claims 3 and 13 are rejected at least for the same reasons as the rejected base claim 1. Dependent claim 15 is rejected at least for the same reasons as the rejected base claim 14.

**Claims 30-31, 33, 35-38, 40, 41, 46, 49, 50, 52, 53, 55**

The Appellant argues that for the independent claim 30, Crawford does not teach or suggest an agreement choice and a deferral choice displayed as a plurality of predefined real estate agreement provisions displayed on a computer screen, as evidenced by the examiner later attempting (unsuccessfully) to rely on Hoyt for similar aspects of other claims. The Examiner disagrees in that, Crawford shows via a color scheme, clause agreement choices and deferred choices( clauses not yet agreed upon or still under negotiation). The reference Hoyt was used to specifically show the concept of not yet completing negotiations and/or not yet starting negotiations on items, is known as deferral. One cannot show non-obviousness by attacking the references

individually where the rejection is based on a combination of references. *In re Young*,  
159 USPQ 725 (CCPA 1968)

Independent claims 38, 49, 50, 52, and 53 also recite similar language, which is  
taught and/or suggested by Crawford.

Dependent claims 31, 33 and 35-37 are rejected at least for the same reasons as  
the rejected base claim 30.

Dependent claims 40, 41, and 46 are rejected at least for the same reasons as  
the rejected base claim 38.

Dependent claim 55 is rejected for at least the same reasons as the rejected  
base claim 53.

**Claims 11,12, 21,22,32,34, 39, 42, 44, and 54**

Claims 11,21,34,42

Dependent claims 11,12,34 and 42 are rejected at least for the same reasons as  
their respective base claims, discussed above.

The Applicant argues that Crawford neither teaches or suggests resolving in a  
later negotiation phase lease provisions that were deferred from a previous negotiation  
phase. Crawford discloses as per Col. 6, lines 45-65, a document having a plurality of  
negotiable clauses and updating the document as each clause is negotiated. This  
suggests that clauses/ phases are deferred from a previous document/phase.

Claims 12, 22

Dependent claims 12 and 22 are rejected at least for the same reasons as their respective base claims, as discussed above.

The Applicant presents, " However, Crawford does not teach or suggest automatically generating an intermediate document that summarizes points of agreement. Crawford merely prepares revised versions of the actual document being negotiated, ..." The Examiner submits that the preparing of revised versions of the actual document is in fact generating intermediate document that summarizes points of agreement.

Claims 32, 39.

Dependent claims 32 and 39 are rejected at least for the same reasons as their respective base claims, as discussed above.

The Appellant says that Crawford does not divide a negotiation transaction into distinct phases. Crawford discloses throughout his presentation " negotiation phases". The Examiner submits that negotiation phases are one in the same as distinct phases of a transaction negotiation.

Claim 44.

Dependent claim 44 is rejected at least for the same reasons as the rejected base claim, as discussed above.

The Appellant presents the negotiation techniques of Crawford but changes the terminology used and then argues that Crawford does not teach the limitation.

As per the previous action:

the step of receiving a first ancillary value from the first negotiator representing a first proposed contract value corresponding to one of the predefined agreement provisions; Col. 9, lines 1-47

the step of receiving a second ancillary value from the second negotiator representing a second proposed contract value corresponding to one of the predefined agreement provisions; Col. 9, lines 1-47.

Crawford '113 discloses the claimed invention, as discussed above, except for if the first ancillary value and the second ancillary value are different, generating a message identifying a discrepancy. However, Crawford '113 does provide displays of discrepancies. Fig. 15. It would have been an obvious matter of design choice to modify the teachings of Crawford '113, to provide the step of if the first ancillary value and the second ancillary value are different, generating a message identifying a discrepancy because the comparisons have been done and the computer program can be designed to not only list/place and manipulate the data to reflect present status, it can be programmed to provide any type of alert. In fact, Crawford '113 does take an action based upon the status of the values by changing their colors for presentation. Since the applicant has not disclosed that if the first ancillary value and the second ancillary value are different, generating a message identifying a discrepancy solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one

of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Crawford '113 will perform the invention as claimed by the applicant with any means, method, or product to if the first ancillary value and the second ancillary value are different, generating a message identifying a discrepancy.

#### Claim 54

Dependent claim 54 is rejected at least for the same reasons as the rejected base claim, as discussed above.

The Appellant submits that predefined structures and sequence of questions are different for the first and the second phases. The Examiner submits that the duplication of an action is not rendered patentable because of the type or kind of data used. The use of structure and questions is the same regardless of the format.

#### ***Issue 2***

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Hoyt et al. (U.S. Pat. No. 6,067,531, hereinafter Hoyt).

Claim 2 is rejected for at least the same reasons as its independent base claim 1.

The Appellant further states, this supposed suggestion is actually the result of the combination, not a motivation to combine the references in the first place, and is therefore impermissible hindsight. The Examiner disagrees in that Hoyt further clarifies the action of a user not addressing clauses in the document presented is in fact a

deferral on the part on the user. The Examiner presented Hoyt in place of Official Notice that not addressing all the items presented in a negotiating document is in fact deferring the non-addressed items.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Issue 3***

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Rickard et al. (U.S. Pat. No. 6,112,189, hereinafter Rickard).

Claim 4 is rejected for at least the same reasons as its independent base claim 1. In addition, Rickard can be combined with Crawford because Crawford does not teach away from the present invention (as discussed above).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In regards to the Appellant's statement :

... the alleged combination still does not teach or suggest:

for each lease provision, determining whether each of the plurality of negotiators has selected the same associated predefined action and, if so, storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non-agreed lease provisions to a later phase of the lease negotiation."

In reference to "determining whether two parties have selected the same predefined action" , Crawford utilizes a color-coded system to show clauses that have yet to be negotiated, and clauses that have been agreed to. Col. 10, lines 40-55.

The Appellant further argues, Crawford does not teach or suggest a plurality of lease provisions and a plurality of predefined actions associated with each lease provision, nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase, as is required by claim 1. The Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and

clauses, which have not yet been agreed to.[ *nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase*]

The Appellant further argues that, in Crawford, there are no predefined actions associated with each lease provision for a negotiator to select. Crawford can thus make no determination whether each of a plurality of negotiators has selected the same associated predefined action. PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention " as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., "lease provision". Crawford teaches about negotiating a document. The limitations/steps required for negotiating a document, or a lease provision, or a purchase contract, as described by Crawford, teaches to the limitations presented by the Appellant. The type of document being negotiated does not render an application allowable because these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The negotiating procedure taught would be performed the same regardless of the type of contract being negotiated.. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The Appellant further argues that, Crawford also does not teach or suggest "storing in the computer an indication of the associated lease provision as an agreed



provision and, if not, deferring non agreed lease provisions to a later phase of the lease negotiation" as recited in claim 1. Because Crawford does not manage a transaction with phases, Crawford cannot affirmatively defer non-agreed lease provisions to a later phase, as does the present invention.

Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. *[ nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase]*

#### ***Issue 4***

Claims 5, 6, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Boesch et al. (U.S. Pat. No. 5,897,621, hereinafter Boesch).

#### **Claims 5 and 6.**

The Appellant argues that claims 5 and 6 are dependent on claim 4, which was rejected over Crawford in view of Rickerd, whereas the present rejection does not include Rickerd. However, since claims 5 and 6 are dependent on claim 4, and claim 4 was rejected with Crawford and Rickerd, the dependency carries over to the rejection of the dependent claims.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In regards to the Appellant's statement :

... the alleged combination still does not teach or suggest:

for each lease provision, determining whether each of the plurality of negotiators has selected the same associated predefined action and, if so, storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non-agreed lease provisions to a later phase of the lease negotiation."

In reference to "determining whether two parties have selected the same predefined action" , Crawford utilizes a color-coded system to show clauses that have yet to be negotiated, and clauses that have been agreed to. Col. 10, lines 40-55.

The Appellant further argues, Crawford does not teach or suggest a plurality of lease provisions and a plurality of predefined actions associated with each lease provision, nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase, as is required by claim 1. The

Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. *[ nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase]*

The Appellant further argues that, in Crawford, there are no predefined actions associated with each lease provision for a negotiator to select. Crawford can thus make no determination whether each of a plurality of negotiators has selected the same associated predefined action. PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention " as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., "lease provision". Crawford teaches about negotiating a document. The limitations/steps required for negotiating a document, or a lease provision, or a purchase contract, as described by Crawford, teaches to the limitations presented by the Appellant. The type of document being negotiated does not render an application allowable because these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The negotiating procedure taught would be performed the same regardless of the type of contract being negotiated.. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re*

*Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The Appellant further argues that, Crawford also does not teach or suggest "storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non agreed lease provisions to a later phase of the lease negotiation" as recited in claim 1. Because Crawford does not manage a transaction with phases, Crawford cannot affirmatively defer non-agreed lease provisions to a later phase, as does the present invention.

Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. [*nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase*]

#### Claims 16 and 17.

Each of rejected dependent claims 5, 6, 16, and 17 are rejected based on the non-allowability of their respective base claims. In addition, Crawford can properly be combined with Boesch because Crawford teaches the present invention (as discussed above).

In addition, Rickard can be combined with Crawford because Crawford does not teach away from the present invention (as discussed above).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In regards to the Appellant's statement :

... the alleged combination still does not teach or suggest:

for each lease provision, determining whether each of the plurality of negotiators has selected the same associated predefined action and, if so, storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non-agreed lease provisions to a later phase of the lease negotiation."

In reference to "determining whether two parties have selected the same predefined action" , Crawford utilizes a color-coded system to show clauses that have yet to be negotiated, and clauses that have been agreed to. Col. 10, lines 40-55.

The Appellant further argues, Crawford does not teach or suggest a plurality of lease provisions and a plurality of predefined actions associated with each lease provision, nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase, as is required by claim 1. The

Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. *[ nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase]*

The Appellant further argues that, in Crawford, there are no predefined actions associated with each lease provision for a negotiator to select. Crawford can thus make no determination whether each of a plurality of negotiators has selected the same associated predefined action. PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention " as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., "lease provision". Crawford teaches about negotiating a document. The limitations/steps required for negotiating a document, or a lease provision, or a purchase contract, as described by Crawford, teaches to the limitations presented by the Appellant. The type of document being negotiated does not render an application allowable because these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The negotiating procedure taught would be performed the same regardless of the type of contract being negotiated.. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re*

*Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The Appellant further argues that, Crawford also does not teach or suggest "storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non agreed lease provisions to a later phase of the lease negotiation" as recited in claim 1. Because Crawford does not manage a transaction with phases, Crawford cannot affirmatively defer non-agreed lease provisions to a later phase, as does the present invention.

Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. [ *nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase*]

## ***Issue 5***

Claims 7-10, 18-20 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Raveis, Jr. (U.S. Pat. No. 6,321,202, hereinafter Raveis).

Dependent claims 7-10 and 18-20 are rejected based on the rejection of their respective independent claims. In addition, Crawford can be properly combined with Raveis because Crawford teaches the present invention (as discussed above).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In reference to the claim sets, 7 and 10, and 18 and 20, the Appellant submits the same argument as previously discussed and addressed and therefore requires no further amplification.

In regards to the Appellant's statement :

... the alleged combination still does not teach or suggest:

for each lease provision, determining whether each of the plurality of negotiators has selected the same associated predefined action and, if so, storing in the computer an indication of the associated lease provision as an agreed provision



and, if not, deferring non-agreed lease provisions to a later phase of the lease negotiation.”

In reference to “determining whether two parties have selected the same predefined action” , Crawford utilizes a color-coded system to show clauses that have yet to be negotiated, and clauses that have been agreed to. Col. 10, lines 40-55.

The Appellant further argues, Crawford does not teach or suggest a plurality of lease provisions and a plurality of predefined actions associated with each lease provision, nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase, as is required by claim 1. The Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. *[ nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase]*

The Appellant further argues that, in Crawford, there are no predefined actions associated with each lease provision for a negotiator to select. Crawford can thus make no determination whether each of a plurality of negotiators has selected the same associated predefined action. PTO’s guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention “ as a whole” would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., “lease provision”.

Crawford teaches about negotiating a document. The limitations/steps required for negotiating a document, or a lease provision, or a purchase contract, as described by Crawford, teaches to the limitations presented by the Appellant. The type of document being negotiated does not render an application allowable because these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The negotiating procedure taught would be performed the same regardless of the type of contract being negotiated.. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The Appellant further argues that, Crawford also does not teach or suggest "storing in the computer an indication of the associated lease provision as an agreed provision and, if not, deferring non agreed lease provisions to a later phase of the lease negotiation" as recited in claim 1. Because Crawford does not manage a transaction with phases, Crawford cannot affirmatively defer non-agreed lease provisions to a later phase, as does the present invention.

Examiner disagrees because, Crawford describes a system for negotiating clauses of a contract and updating clauses to reflect the last of the modifications. Crawford also visually codes displays to distinguish between clauses that have been negotiated and clauses, which have not yet been agreed to. [*nor determining whether two parties have selected the same predefined action or deferred agreement to a later distinct phase*]

The Appellant in claims 18 and 20 has named the negotiators tenant and landlord with the same structure and method. As noted, differences that are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited do not provide patentable weight or consideration. The matching of agreeable clauses and deferring to a later date/phase and storing the results in a computer would occur regardless who the participants were and would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to name the negotiators, tenant, landlord, buyer, seller, etc., because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

#### Claim 29

Claim 29 is rejected at least based on the rejection of its respective base claim.

#### Claims 8, 9, 19

Claims 8, 9 and 19 are further rejected because Crawford and Raveis teach or suggest electronically transmitting to the third-party service provider a request for services pre-populated with information pertaining to the lease negotiation. Col. 11-12, lines 1-67[Raveis] Raveis provides description of informing parties to a transaction of third-party services, Raveis does electronically transmit to the third-party service provider a request for services pre-populated with information pertaining to the lease negotiation.

***Issue 6***

Claims 23, 27 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke et al. (U.S. Pat. No. 6,131,087, hereinafter Luke). Crawford is properly combined with Luke (as discussed above).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Examiner further submits that Crawford does determine options (lease provisions) for which the first and second parties have selected (discussed above).

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Crawford further discloses those lease provisions for which the first and second parties have not selected the same predefined action, assisting the first and second parties in reaching agreement as stated in the prior action.

Also, similar to claim 30, discussed above, independent claims 23 and 48 each recite, inter alia, "a plurality of lease provisions and a plurality of predefined actions associated with each lease provision," which is taught and/or suggested by Crawford in combination with Luke.

Claim 27, dependent on claim 23, is rejected for at least the same reasons as claim 23 as discussed above.

### ***Issue 7***

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke and Raveis.

The combination of Luke and/or Raveis with Crawford is proper, as discussed above.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Also, Raveis does cure the deficiencies of Crawford and/or Luke as discussed above, and claim 24 is therefore rejected for at least the same reasons as base claim 23.

In addition, claim 24 recites in pertinent part "generating a request for services from a local service provider." As discussed above, Crawford, Luke, and Raveis teach and/or suggest transmitting information to a service provider. Raveis provides contact information and a follow up on the satisfaction of the service rendered. Col. 11-12, lines 1-67.

***Issue 8***

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke, Raveis, and Boesch.

The combination with Crawford is proper, as discussed above.

The examiner states the combination would be obvious "in order to facilitate international commerce." However, this is hindsight motivation and is therefore impermissible.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim 25 is therefore rejected for at least the same reasons as its base claim 23.

### ***Issue 9***

Claims 26 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke and Rickerd.

The combination of Luke and/or Rickerd with Crawford is proper, as discussed above. The examiner states that it would have been obvious to combine the references "in order to facilitate expediting the negotiation process." Once again, while this may be the end result of the combination, it is not a valid suggestion to combine the references in the first place.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claims 26 and 45 are therefore rejected for at least the same reasons as their respective base claims, in addition to the additional features recited in each claim.

***Issue 10***

Claims 51 and 56-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Hoyt.

Claim 51

Claim 51 is rejected for similar reasons as claim 1, and also because the combination of Crawford and Hoyt is proper because Crawford teaches the present invention, and because the examiner has provided evidence of suggestion or motivation to combine Crawford and Hoyt, as discussed above.

In addition, Hoyt does cure the deficiencies of Crawford. That is, the final office action asserts that Hoyt describes a system whereby choices of AGREE and DEFER are provided. Hoyt describes a system that notifies a user when a contract component is incomplete or in error and have been concluded. Hoyt, col. 31, lines 17-19. Figure 13 of Crawford shows an issue that has been agreed upon.

Claims 56 and 57

Claim 56 is rejected for similar reasons as claim 1, and also because the combination of Crawford and Hoyt is proper because Crawford teaches the present invention, and because the examiner has provided evidence of suggestion or motivation to combine Crawford and Hoyt, as discussed above.



In addition, Hoyt does cure the deficiencies of Crawford. That is, the final office action asserts that Hoyt describes a system whereby choices of AGREE and DEFER are provided. To the contrary, at col. 30, line 59 - col. 31, line 67, Hoyt merely describes a system that notifies a user when a contract component is incomplete or in error. Hoyt, col. 31, lines 17-19. Nowhere does Hoyt teach or suggest AGREE and/or DEFER choices.

Furthermore, claim 56 recites additional limitations shown in the prior art, e.g., an amount of currency, a square footage to be leased, beginning date and terms of a lease, and a summary document.

PTO's guide lines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In these pending claims, the examiner submits that the particular language does not serve as a limitation on the claim (i.e., "amount of currency, a square footage to be leased, beginning date and terms of a lease, and a summary document."). The Examiner submits that the aforementioned prior art will perform the negotiation function with whatever data format is required/specified. The type/name of the data does not render an Application patentable.

Claim 57 is rejected based on the rejection of base claim 56.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Daniel I. Greene

Examiner

Art Unit 3621

DLG  
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Conferees  
Eric Stamber  
John W. Hayes

Banner & Witcoff LTD  
1001 G Street NW  
Washington, DC 20001-4597



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3500